



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/523,193	03/10/2000	Sean Matthew Doherty	169.1649	4782

5514 7590 09/04/2003

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

YOUNG, JOHN L

ART UNIT PAPER NUMBER

3622

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/523,193

Applicant(s)
Doherty

Examiner
John Young

Art Unit
3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 10, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

[Handwritten signature]
8-29-03

Art Unit: 3622

REQUEST FOR CONTINUING PROSECUTION APPLICATION (CPA)

1. The request for (CPA) filed on 06/10/2003, paper#15, based on parent Application No. 09/523,193 is acceptable and a CPA has been established. An action on the CPA, paper#17 follows:

STATUS OF CLAIMS

2. Claims 1-28 are pending.

DRAWINGS

3. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

4. Rejections Maintained for claims 1-28.

PRIOR CLAIM REJECTIONS — 35 U.S.C. §103(a)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 3622

5. Claims 1-13, 15-25 & 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over Dimitriadis et al. 5,664,948 (09/09/1997) (herein referred to as "Dimitriadis").

As per claim 1, Dimitriadis (col. 5, ll. 6-31; the ABSTRACT; FIG. 2; FIG. 3; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 1.

Dimitriadis (col. 2, ll. 11-17) discloses: "*Presentation of the advertising information at the receiving device may be triggered by a variety of functions. Stored advertising information entries may be presented, for example, by reference to a time schedule, to current receiving device location, or to receiving device events such as power-up.*"

In this case the Examiner interprets: "*Stored advertising information entries may be presented, for example, by reference to a time schedule*" as suggesting a "method of scheduling items of information. . . ."

Also, the Examiner interprets: "*current receiving device location, or to receiving device events such as power-up. . . .*" as suggesting: "each item of information having an associated priority which is a function of time. . . ."

Also, the Examiner interprets: "*Stored advertising information entries may be presented, for example, by reference to a time schedule, to current receiving device location, or to receiving device events such as power-up. . . .*" as suggesting

Art Unit: 3622

“rescheduling items of information in accordance with the values of the priorities at a time after termination of the user interrupt.”

Also, the Examiner interprets: “*events such as power-up*” as suggesting “activating a user interrupt in response to user input. . . .”

Dimitriadis lacks an explicit recitation of “activating a user interrupt in response to user input. . . .”

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Dimitriadis (col. 2, ll. 12-17; FIG. 7; FIG. 2; and col. 8, ll. 49-60) would have been selected in accordance with “activating a user interrupt in response to user input. . . .” because such selection would have provided means “*to make the processor delivering advertising information . . . more efficient. . . .* [See Dimitriadis (col. 1, ll. 60-63) because] *the advertising information is broadcast only one time and presented multiple times. . . .*” (see Dimitriadis (col. 1, ll. 60-63)).

As per claim 2, Dimitriadis shows the method of claim 1. (See the rejection of claim 1 supra).

Dimitriadis (col. 1, ll. 32-67; col. 5, ll. 6-31; the ABSTRACT; FIG. 2; FIG. 3; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 2.

Art Unit: 3622

Dimitriadis (col. 1, ll. 31-40) discloses: “Advertisers expend substantial effort and expense in maximizing the number of listeners by timing advertisement broadcasts with expected times of target listening audiences. In other words, an advertisement is broadcast at particular times with the hope that the maximum number of listeners are exposed to the advertisement. Accordingly, certain broadcast times become most popular for advertisement broadcast. . . .”

The Examiner interprets this disclosure as suggesting: “estimating a time when the user input will terminate. . . .”

Dimitriadis lacks an explicit recitation of “estimating a time when the user input will terminate. . . .”

For example, it would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Dimitriadis (col. 1, ll. 31-40; col. 5, ll. 6-31; the ABSTRACT; FIG. 2; FIG. 3; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; col. 8, ll. 49-60; and FIG. 7) would have been selected in accordance with “estimating a time when the user input will terminate. . . .” because such selection would have provided means “to make the processor delivering advertising information . . . more efficient.” (See Dimitriadis (col. 1, ll. 60-63)).

As per claim 3, Dimitriadis shows the method of claim 2. (See the rejection of claim 2 supra).

Art Unit: 3622

Dimitriadis (col. 5, ll. 6-31; the ABSTRACT; FIG. 2; FIG. 3; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 3.

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 3.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Dimitriadis (col. 5, ll. 6-31; the ABSTRACT; FIG. 2; FIG. 3; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; col. 8, ll. 49-60; and FIG. 7) would have been selected in accordance with "said method repeats said estimating step . . . and . . . rescheduling . . . for a further estimated time. . . ." because such selection would have provided means "*to make the processor delivering advertising information . . . more efficient.*" (See Dimitriadis (col. 1, ll. 60-63)).

As per claim 4, Dimitriadis shows the method of claim 1. (See the rejection of claim 1 supra).

Dimitriadis (the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; and FIG. 8) shows elements that suggest the elements and limitations of claim 4.

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 4.

Art Unit: 3622

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Dimitriadis (the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; and FIG. 8) would have been selected in accordance with “wherein one or more of the priorities are dependent upon one or more parameters as a function of time. . . .” because such selection would have provided means “*to make the processor delivering advertising information . . . more efficient.*” (See Dimitriadis (col. 1, ll. 60-63)).

As per claim 5, Dimitriadis shows the method of claim 4. (See the rejection of claim 4 supra).

Dimitriadis (the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; and FIG. 8) shows elements that suggest the elements and limitations of claim 5.

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 5.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Dimitriadis (the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; and FIG. 8) would have been selected in accordance with “wherein one of the priorities is dependent upon a location or distance from a given location. . . .” because such selection would have provided means “*to make the*

Art Unit: 3622

processor delivering advertising information . . . more efficient." (See Dimitriadis (col. 1, ll. 60-63)).

As per claim 6, Dimitriadis shows the method of claim 4. (See the rejection of claim 4 supra).

Dimitriadis (the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 6.

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 6.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Dimitriadis (the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) would have been selected in accordance with "wherein one of the priorities is dependent upon a frequency that the associated item of information is displayed. . . ." because such selection would have provided means "*to make the processor delivering advertising information . . . more efficient.*" (See Dimitriadis (col. 1, ll. 60-63)).

Art Unit: 3622

As per claim 7, Dimitriadis shows the method of claim 4. (See the rejection of claim 4 supra).

Dimitriadis (the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 7.

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 7.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Dimitriadis (the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) would have been selected in accordance with “wherein one of the priorities is dependent upon a time since the associated item of information was last displayed. . . .” because such selection would have provided means “*to make the processor delivering advertising information . . . more efficient.*” (See Dimitriadis (col. 1, ll. 60-63)).

As per claim 8, Dimitriadis shows the method of claim 4. (See the rejection of claim 4 supra).

Art Unit: 3622

Dimitriadis (the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 8.

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 8.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Dimitriadis (the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) would have been selected in accordance with “wherein one of the priorities is dependent upon a number of times the associated item of information has been displayed. . . .” because such selection would have provided means “*to make the processor delivering advertising information . . . more efficient.*” (See Dimitriadis (col. 1, ll. 60-63)).

As per claim 9, Dimitriadis shows the method of claim 4. (See the rejection of claim 4 supra).

Dimitriadis (col. 1, ll. 26-40; the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 9.

Art Unit: 3622

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 9.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Dimitriadis (the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) would have been selected in accordance with “wherein one of the priorities is dependent upon a cost of the associated item of information. . . .” because such selection would have provided means “*to make the processor delivering advertising information . . . more efficient.*” (See Dimitriadis (col. 1, ll. 60-63)).

As per claim 10, Dimitriadis shows the method of claim 1. (See the rejection of claim 1 supra).

Dimitriadis (col. 1, ll. 26-40; the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 10.

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 10.

“Official Notice” is taken that both the concept and the advantages of “generating a user profile based upon the monitoring. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include

Art Unit: 3622

“generating a user profile based upon said monitoring. . . .” in the method of Dimitriadis because would have provided means “*to make the processor delivering advertising information . . . more efficient.*” (See Dimitriadis (col. 1, ll. 60-63)).

As per claim 11, Dimitriadis shows the method of claim 10. (See the rejection of claim 10 supra).

Dimitriadis (col. 1, ll. 26-40; the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 11.

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 11.

“Official Notice” is taken that both the concept and the advantages of “wherein one of the priorities is dependent upon the user profile. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include. “wherein one of said priorities is dependent upon the user profile. . . .” in the method of Dimitriadis because would have provided means “*to make the processor delivering advertising information . . . more efficient.*” (See Dimitriadis (col. 1, ll. 60-63)).

Art Unit: 3622

As per claim 12, Dimitriadis shows the method of claim 1. (See the rejection of claim 1 supra).

Dimitriadis (col. 1, ll. 26-40; the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 12.

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 12.

“Official Notice” is taken that both the concept and the advantages of the elements and limitations of claim 12 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include the elements and limitations of claim 12 in the method of Dimitriadis because would have provided means “to make the processor delivering advertising information . . . more efficient.” (See Dimitriadis (col. 1, ll. 60-63)).

As per claim 13, Dimitriadis shows the method of claim 1. (See the rejection of claim 1 supra).

Dimitriadis (col. 1, ll. 26-40; the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 13.

Art Unit: 3622

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 13.

“Official Notice” is taken that both the concept and the advantages of the elements and limitations of claim 13 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include the elements and limitations of claim 13 in the method of Dimitriadis because would have provided means *“to make the processor delivering advertising information . . . more efficient.”* (See Dimitriadis (col. 1, ll. 60-63)).

As per claim 15, Dimitriadis shows the method of claim 14. (See the rejection of claim 14 *supra*).

Dimitriadis (col. 5, ll. 6-31; the ABSTRACT; FIG. 2; FIG. 3; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 15.

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 15.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Dimitriadis (col. 5, ll. 6-31; the ABSTRACT; FIG. 2; FIG. 3; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; col. 8, ll. 49-60; and FIG. 7) would have been selected in accordance with “wherein one or more **of the** priorities is

Art Unit: 3622

dependent upon one or more parameters as a function of time. . . .” because such selection would have provided means *“to make the processor delivering advertising information . . . more efficient.”* (See Dimitriadis (col. 1, ll. 60-63)).

As per claim 16, Dimitriadis shows the method of claim 15. (See the rejection of claim 15 supra).

Dimitriadis (col. 5, ll. 6-31; the ABSTRACT; FIG. 2; FIG. 3; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 16.

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 16.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Dimitriadis (col. 5, ll. 6-31; the ABSTRACT; FIG. 2; FIG. 3; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; col. 8, ll. 49-60; and FIG. 7) would have been selected in accordance with “wherein one of the priorities is dependent upon a location or distance from a given location. . . .” estimating a time the user input will terminate. . . .” because such selection would have provided means *“to make the processor delivering advertising information . . . more efficient.”* (See Dimitriadis (col. 1, ll. 60-63)).

Art Unit: 3622

As per claim 17, Dimitriadis shows the method of claim 15. (See the rejection of claim 15 supra).

Dimitriadis (the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 17.

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 17.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Dimitriadis (the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) would have been selected in accordance with “wherein one of the priorities is dependent upon a frequency the associated item of information is displayed. . .” because such selection would have provided means “*to make the processor delivering advertising information . . . more efficient.*” (See Dimitriadis (col. 1, ll. 60-63)).

As per claim 18, Dimitriadis shows the method of claim 15. (See the rejection of claim 15 supra).

Art Unit: 3622

Dimitriadis (the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 18.

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 18.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Dimitriadis (the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) would have been selected in accordance with “wherein one of the priorities is dependent upon a time since the associated item of information was last displayed. . . .” because such selection would have provided means “*to make the processor delivering advertising information . . . more efficient.*” (See Dimitriadis (col. 1, ll. 60-63)).

As per claim 19, Dimitriadis shows the method of claim 15. (See the rejection of claim 15 supra).

Dimitriadis (the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 19.

Art Unit: 3622

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 19.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Dimitriadis (the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) would have been selected in accordance with “wherein one of the priorities is dependent upon a number of times the associated item of information has been displayed. . . .” because such selection would have provided means “*to make the processor delivering advertising information . . . more efficient.*” (See Dimitriadis (col. 1, ll. 60-63)).

As per claim 20, Dimitriadis shows the method of claim 15. (See the rejection of claim 15 supra).

Dimitriadis (col. 1, ll. 26-40; the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 20.

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 20.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Dimitriadis (the ABSTRACT; col. 2, ll. 1-20; col. 1, ll.

Art Unit: 3622

60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) would have been selected in accordance with “wherein one of said priorities is dependent upon a cost of the associated item of information. . . .” because such selection would have provided means “*to make the processor delivering advertising information . . . more efficient.*” (See Dimitriadis (col. 1, ll. 60-63)).

As per claim 21, Dimitriadis shows the method of claim 14. (See the rejection of claim 14 supra).

Dimitriadis (col. 1, ll. 26-40; the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 21.

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 21.

“Official Notice” is taken that both the concept and the advantages of “generating a user profile based upon the monitoring. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include “generating a user profile based upon said monitoring. . . .” in the method of Dimitriadis because would have provided means “*to make the processor delivering advertising information . . . more efficient.*” (See Dimitriadis (col. 1, ll. 60-63)).

Art Unit: 3622

As per claim 22, Dimitriadis shows the method of claim 21. (See the rejection of claim 21 supra).

Dimitriadis (col. 1, ll. 26-40; the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 22.

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 22.

“Official Notice” is taken that both the concept and the advantages of “wherein one of the priorities is dependent upon the user profile. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include “ “wherein one of said priorities is dependent upon the user profile. . . .” in the method of Dimitriadis because would have provided means “*to make the processor delivering advertising information . . . more efficient.*” (See Dimitriadis (col. 1, ll. 60-63)).

As per claim 23, Dimitriadis shows the method of claim 14. (See the rejection of claim 14 supra).

Dimitriadis (col. 1, ll. 26-40; the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 23.

Art Unit: 3622

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 23.

“Official Notice” is taken that both the concept and the advantages of the elements and limitations of claim 23 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include the elements and limitations of claim 23 in the method of Dimitriadis because would have provided means *“to make the processor delivering advertising information . . . more efficient.”* (See Dimitriadis (col. 1, ll. 60-63)).

As per claim 24, Dimitriadis shows the method of claim 14. (See the rejection of claim 14 supra).

Dimitriadis (col. 1, ll. 26-40; the ABSTRACT; col. 2, ll. 1-20; col. 1, ll. 60-67; col. 3, ll. 1-67; FIG. 1; FIG. 2; FIG. 3; FIG. 8; col. 5, ll. 6-31; col. 8, ll. 49-60; and FIG. 7) shows elements that suggest the elements and limitations of claim 24.

Dimitriadis lacks an explicit recitation of all of the elements and limitations of claim 24.

“Official Notice” is taken that both the concept and the advantages of the elements and limitations of claim 24 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include the elements and limitations of claim 24 in the method of Dimitriadis because would have provided means

Art Unit: 3622

“to make the processor delivering advertising information . . . more efficient.” (See Dimitriadis (col. 1, ll. 60-63)).

Claim 25 is rejected for substantially the same reasons as claim 1.

Claim 27 is rejected for substantially the same reasons as claim 1.

NEW CLAIM REJECTIONS — 35 U.S.C. §103(a)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 14, 26 & 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Dimitriadis et al. 5,664,948 (09/09/1997) (herein referred to as “Dimitriadis”).

As per claim 146, Dimitriadis (FIG. 3) discloses: “A method of displaying items of information on a display apparatus comprising a display unit and an[sic] user interface, each item of information having an associated priority which is a function of time. . . .”

Dimitriadis (the ABSTRACT; col. 1, ll. 63-67; and col. 2, ll. 1-18; col. 5, ll. 52-67; col. 6, ll. 1-9; and col. 6, ll. 32-67) discloses: “scheduling items of information in accordance with values of the priorities . . . [and] repetition means for repeating the steps

Art Unit: 3622

(d) to (e) [i.e.,] estimating a time when the user will finish interacting with the user interface . . . and rescheduling items of information in accordance with the values of the priorities at the estimated time. . . .” The Examiner interprets: “*current receiving device location, or to receiving device events such as power-up. . . .*” as showing “each item of information having an associated priority which is a function of time. . . .”

Dimitriadis (col. 5, ll. 37-51) discloses: “*tuning and station selection information relative to the voice radio receiver. . . .*” In this case, the Examiner interprets this disclosure as showing “generating a user interrupt in response to a user interacting with the user interface . . . clearing the scheduled items of information in response to the user interrupt. . . .”

Dimitriadis (col. 6, ll. 16-51) discloses: “*targets an appropriate time slot. . . .*” In this case, the Examiner interprets this disclosure as showing “estimating a time when the user will finish interacting with the user interface . . . [and] rescheduling items of information in accordance with the values of the priorities at the estimated time . . . [and] displaying the scheduled information according to priority, if the user is not interacting with the user interface at the estimated time. . . .”

Dimitriadis lacks an explicit recitation of “generating a user interrupt in response to a user interacting with the user interface. . . .”

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Dimitriadis (col. 2, ll. 12-17; FIG. 7; FIG. 2; and col. 8,

Art Unit: 3622

ll. 49-60) would have been selected in accordance with “generating a user interrupt in response to a user interacting with the user interface. . . .” because such selection would have provided means “*to make the processor delivering advertising information . . . more efficient. . . .* [See Dimitriadis (col. 1, ll. 60-63) because] *the advertising information is broadcast only one time and presented multiple times. . . .*” (see Dimitriadis (col. 1, ll. 60-63)).

As per claim 26, Dimitriadis (FIG. 3) discloses: “An apparatus that displays items of information on a display apparatus, the display apparatus comprising a display unit and a user interface, each item of information having an associated priority which is a function of time. . . .”

Dimitriadis (the ABSTRACT; col. 1, ll. 63-67; and col. 2, ll. 1-18; col. 5, ll. 52-67; col. 6, ll. 1-9; and col. 6, ll. 32-67) discloses: “scheduler means for scheduling items of infirmity in accordance with values of the priorities . . . [and] repetition means for repeating the operations of the estimation means and the rescheduler means, if the user is still interacting with the user interface at the estimated time. . . .” The Examiner interprets: “*current receiving device location, or to receiving device events such as power-up. . . .*” as showing “each item of information having an associated priority which is a function of time. . . .”

Art Unit: 3622

Dimitriadis (col. 5, ll. 37-51) discloses: “*tuning and station selection information relative to the voice radio receiver. . . .*” In this case, the Examiner interprets this disclosure as showing “generator means for generating a user interrupt in response to a user interacting with the user interface; clearing means for clearing the scheduled items of informatin in response to the user interrupt. . . .”

Dimitriadis (col. 6, ll. 16-51) discloses: “*targets an appropriate time slot. . . .*” In this case, the Examiner interprets this disclosure as showing “estimation means for estimating a time when the user will finish interacting with the user interface . . . [and] rescheduler means for scheduling items of informatin in accordance with the values of the priorities at the estimated time . . . [and] display means for displaying the scheduled informatin according to priority, if the user is not interacting with the user interface at the estimated time. . . .”

Dimitriadis lacks an explicit recitation of “generator means for generating a user interrupt in response to a user interacting with the user interface. . . .”

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Dimitriadis (col. 2, ll. 12-17; FIG. 7; FIG. 2; and col. 8, ll. 49-60) would have been selected in accordance with “generator means for generating a user interrupt in response to a user interacting with the user interface. . . .” because such selection would have provided means “*to make the processor delivering advertising information . . . more efficient. . . .* [See Dimitriadis (col. 1, ll. 60-63) because] *the*

Art Unit: 3622

advertising information is broadcast only one time and presented multiple times. . . .”

(see Dimitriadis (col. 1, ll. 60-63)).

Claim 28 is rejected for substantially the same reasons as claim 26.

RESPONSE TO ARGUMENTS

7. Applicant's response (Amendment C, paper#13, filed 05/12/2003) has been considered in view of the prior Office Action but is not persuasive for the following reasons:

In response to Applicant's argument (Amendment C, p. 14, ll. 13-23; and p. 15, ll. 1-12) which asserts that “to infer steps (b) and (c) [of claim 1] from the disclosure of Dimitriadis, et al. would be to benefit inappropriately from the hindsight vision afforded by the present application.” This is not the case.

It is well settled in the law that “any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the prior Office Action relies on knowledge generally available to one of ordinary skill in the art and asserts that the teachings of the Dimitriadis reference in conjunction with the knowledge of one of

Art Unit: 3622

ordinary skill in the art either teach or suggest all of the elements and limitations of the instant invention. ““The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’ *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).” (See MPEP 2134.01).

Applicant's argument (Amendment C, p. 15, ll. 13-18) asserts that the cited prior art reference “provides no teaching or suggestion of a rescheduling step after termination of a user interrupt.”

It is well settled that ““The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’ *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).” (See MPEP 2134.01).

Dimitriadis (col. 2, ll. 11-17) discloses: “*Presentation of the advertising information at the receiving device may be triggered by a variety of functions. Stored advertising information entries may be presented, for example, by reference to a time*

Art Unit: 3622

schedule, to current receiving device location, or to receiving device events such as power-up.”

In this case the Examiner interprets: “*Stored advertising information entries may be presented, for example, by reference to a time schedule, to current receiving device location, or to receiving device events such as power-up. . . .*” as suggesting “rescheduling items of information in accordance with the values of the priorities at a time after termination of the user interrupt.”

Applicant's argument (Amendment C, p. 15, ll. 19-23; and p. 16, ll. 1-3) asserts that Dimitriadis “teaches away from the present invention. This is not the case.

It is well settled in the law that “Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments.” (See *In re Susi*, 169 USPQ 423 (CCPA 1971).

Applicant's argument (Amendment C, p. 16, ll. 4-16) suggests that the motivation to modify the teachings of Dimitriadis is improper motivation. This is not the case.

It is well settled that in order to establish motivation to modify or combine references, “it is not necessary that a reference actually suggest changes or possible improvements which Applicant made.” (See *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). And, it is well settled in the law that “It is not necessary that the prior art

Art Unit: 3622

suggest the combination to achieve the same advantage or result discovered by the applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). . . .” (See MPEP 2144 RATIONALE DIFFERENT FROM APPLICANT’S IS PERMISSIBLE (August 2001) p. 2100-127.

Applicant's argument (Amendment C, p. 16, ll. 17-23) asserts that the cited prior art reference “does not teach or suggest scheduling items in accordance with values of associated priorities.” This is not the case.

It is well settled that “‘The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’ *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).” (See MPEP 2134.01).

Dimitriadis (col. 2, ll. 11-17) discloses: “*Presentation of the advertising information at the receiving device may be triggered by a variety of functions. Stored advertising information entries may be presented, for example, by reference to a time schedule, to current receiving device location, or to receiving device events such as power-up.*”

Art Unit: 3622

In this case the Examiner interprets: *“Stored advertising information entries may be presented, for example, by reference to a time schedule, to current receiving device location, or to receiving device events such as power-up. . . .”* as suggesting scheduling items in accordance with values of associated priorities.”

In response to Applicant's argument (Amendment C, p. 17, ll. 3-6) which asserts that “Claims 25 and 27 patentably define the present invention over Dimitriadis, et al. for at least the reasons given . . . with respect to Claim 1. . . .”, Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the prior art reference applied. Furthermore, claims 25 and 27 are rejected for substantially the same reasons as claim 1.

As per claim 14, and in response to Applicant's argument (Amendment C, p. 17, ll. 7-25; p. 18; and p. 19, ll. 1-14) which asserts that the prior Office Action fails to “establish prima facie obviousness of the claimed invention. . . .” Applicant's argument is moot in light of the new rejection of claim 14 presented above.

In response to Applicant's argument (Amendment C, p. 19, ll. 15-23) which asserts that “Claims 26 and 28 patentably define the present invention over Dimitriadis, et al. for

Art Unit: 3622

at least the reasons given with respect to Claim 14. . . .”, Applicant’s arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the prior art reference applied. And, Applicant’s argument is moot in light of the new rejections of claims 26 & 28 presented above. Furthermore, claims 26 and 28 are rejected for substantially the same reasons as claim 14.

In response to Applicant's argument (Amendment C, p. 19, ll. 26-28; and p. 20) which asserts that the dependent claims in the instant application are allowable because they depend from allowable independent claims, Applicant’s arguments amount to a general allegation that the dependent claims define a patentable invention without specifically pointing out how the language of the dependent claims patentably distinguishes them from the prior art reference applied.

NOTE: Applicant's arguments in a prior response failed to seasonably challenge Official Notice evidence presented in the prior Office Action for the rejections of claims 10-13 and 21-24; therefore, said Official Notice evidence is admitted by Applicant; no further references are required to be submitted by the Office. (See MPEP 2144.03 Reliance on Common Knowledge in the Art or ‘Well Known’ Prior Art 8 ed., August 2001, pp. 2100-129 and 2100-130).

Serial Number: 09/523,193

(Doherty)

32

Art Unit: 3622

CONCLUSION

8. Any response to this action should be mailed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Serial Number: 09/523,193

(Doherty)

33

Art Unit: 3622

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


John L. Young

Patent Examiner

August 29, 2003